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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,932	01/26/2004	John M. MacLaren	200301725-4	9646

7590 07/13/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

DUVERNE, JEAN F

ART UNIT PAPER NUMBER

2839

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/764,932

Applicant(s)

MACLAREN ET AL.

Examiner

Jean F. Duverne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-29 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-29 of prior U.S. Patent No. US006692293B2 . This is a double patenting rejection.

3. MacLauren's device discloses a first substrate configured to provide location identification signals or identifiers (see lines 1-3 of claims 1) to a plurality of locations on the first substrate; a plurality of connectors coupled to the first substrate at the plurality of locations, each connector comprising an identification device uniquely configured to provide substrate location information and to receive the corresponding location identification signals; and a plurality of second substrates, each second substrate

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coupled to a corresponding connector such that the unique identification device couples the corresponding location identification signals or identifier (see abstract) to the second substrate (see claims 1, 12, 18); wherein the first substrate is configured to receive five connectors (see claims 2, 13); wherein each connector comprises a memory cartridge connector (see claims 3, 14, 19); wherein the first substrate is configured to receive an array of connectors arranged in a plurality of rows and columns (see claims 4, 14); wherein each connector comprises a memory cartridge connector (see claims 5, 16); wherein each identification device comprises a plurality of contacts uniquely configured to be coupled to one of a logical high signal and a logical low signal (see claims 6, 17, 20); wherein the uniquely configured identification device represents a physical location of the corresponding connector with respect to the first substrate (see claims 7, 21); wherein the uniquely configured identification device represents an electrical location of the corresponding connector with respect to the first substrate (claims 8, 22); wherein each of the plurality of second substrates comprises a plurality of memory modules; wherein each of the plurality of memory modules comprises a plurality of memory devices (claim 9); wherein each of the plurality of second substrates comprises a memory controller (claim 11); (b) coupling a plurality of connectors to the first substrate, the connectors each comprising a plurality of contacts and traces arranged in a unique configuration with respect to the others of the plurality of connectors, wherein the unique contact and trace configuration provides location information; (c) electrically coupling each of the plurality of contacts to the first substrate; (d) providing a logical signal to each of the plurality of contacts, the logical signals

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providing a unique identifier for each of the plurality of connectors, wherein the unique identifier corresponds to a unique location of one of the plurality of connectors; (e) coupling a plurality of second substrates to the plurality of connectors; (f) electrically coupling the plurality of second substrates to the plurality of contacts; (g) latching the plurality of logical signals of the plurality of contacts to a plurality of control devices existing on the plurality of second substrates (see claims 23).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Duverne whose telephone number is (571) 272-2091. The examiner can normally be reached on 9:00-7:30, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action may be mailed to:  
Commissioner for Patents**

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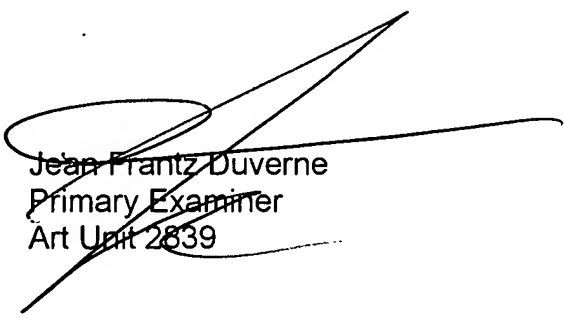
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For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

**Or Faxed to:**  
(703) 872-9306.

JFD

07/11/2004



Jean Prantz Duverne  
Primary Examiner  
Art Unit 2839